

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERNOT HAUSCH,
CHRISTIAN RADELOFF and GERD RAUSCHER

Appeal No. 1996-3776
Application 08/224,074

HEARD: March 23, 2000

Before GARRIS, WARREN and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 2 through 9 and 11 through 15.¹ The examiner has withdrawn the ground of rejection advanced on appeal with respect to claims 14 and 15 (answer, page 4), leaving claims 2 through 9 and 11

¹ See the amendment of April 7, 1994 (Paper No. 12). While the examiner has indicated that claims 14 and 15 would be allowable if rewritten to include “all of the limitations of the base claim and any intervening claims including claims 12 and 13” (answer, page 4), we observe that claims 14 and 15 are solely dependent on claim 11 and not on any of the intervening claims. And there is no indication in the record that appellants will amend the claims to include any of the intervening limitations.

through 13 for consideration on appeal.

We have carefully considered the record before us, and based thereon, find that we cannot sustain the ground of rejection of the appealed claims under 35 U.S.C. § 103 over Radeloff et al. (Radeloff).² Throughout the answer, the examiner contends that the “materials” for the “composite member” specified in claim 11 “overlap with,” “read on” or are “taught by” and thus obvious over the “iron alloys” and the “soft magnetic material” taught by Radeloff (pages 4, 5, 6, and 7). Appellants point to the Radeloff declaration³ and submit that Radeloff states, *inter alia*, in ¶ 4 of his declaration that “although he has not made every possible alloy permutation within the different alloy systems disclosed in [Radeloff], he has made a large number of alloys of each system which he has also tested” and “has not observed any alloys made according to [Radeloff] having a composition range also within the composition range of the present application which exhibit the properties disclosed and claimed in the present application” (brief, page 11). We find that the examiner has not responded to appellants’ argument and evidence in the declaration with respect to this critical fact underlying the *prima facie* case in his answer.

It is well settled that upon the submission of evidence or argument by appellants to the examiner’s initial finding that the claimed invention is *prima facie* obvious over the applied prior art, the patentability of the claimed invention over the applied prior art is again determined on the totality of the record with due consideration given to appellants’ arguments. Thus, the examiner has the burden of reestablishing a *prima facie* case of obviousness based on the totality of the record including appellants’ submission taken in light of their arguments in order to continue rejecting the claims. *See generally In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Eli Lilly & Co.*, 902 F.2d 943, 948, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Accordingly, because the examiner has not responded to appellants’ evidence and argument that the materials of Radeloff do not fall within the limitations of the appealed claims, the examiner has not satisfied the burden of reestablishing the *prima*

² See page 3 of the answer.

³ The Radeloff declaration was submitted on March 10, 1995 (Paper No. 16).

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